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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,746	10/22/2003	Dae-Sung Han	1594.1294	4347

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EXAMINER

PRICE, CARL D

ART UNIT

PAPER NUMBER

3749

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/689,746

Applicant(s)

HAN ET AL.

Examiner

CARL D. PRICE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 11/30/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argues *"there is indeed no teaching, suggestion, or motivation found either explicitly or implicitly in either Potts or JP .440 to make the suggested modification of the JP '440 grill pipes"*. With regard to whether either Potts or JP '440 either explicitly or implicitly teaching, suggestion, or provide motivation to make the suggested modification, one need only recognize that the hollow tubular metal "grid" (27) of Potts and grill pipes (6) of JP '440, respectively, are each for providing a support on which food directly rests during cooking (i.e. – "grilling meat or fish" (e.g. – JP '440) and "steak or other pieces of meat" (i.e.-Potts). In this regard each of the prior art references of JP '440 and Potts teach hollow tubular grate arrangements and explicitly suggest the use of such an arrangement for supporting food during broiling, or grilling. In this regard, the examiner maintains that it would have been obvious to a

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person having ordinary skill in the art to modify the cross section of the JP '440 pipes to be oval, in view of the teaching of Potts.

Applicant further argues, "even if there were a motivation to modify the grill pipes in the JP '440 reference, the shape of the tubes 27, in Potts, would not provide a design inspiration". The examiner maintains the position that, since the relative height and width dimensions of the tubes would necessarily depend on numerous design parameters such as the length of the pipes, operating temperature, pipe material, etc. to dimension the relative height and width of the JP '440 pipes according to the values set forth in applicant's claims can be viewed as nothing more than merely a matter of choice in design absent the showing of any new or unexpected results there from over the prior art of record. Applicant argues *"that the specification clearly explains the reasoning behind designing the grill pipes to have shapes in accordance with former claims 2 and 8"* And, that *"In other words, applicants assed that the shape of the grill pipes is not merely a design choice, but rather, a result of an understanding of the benefits of a particular shape in accordance with the claim language. Additionally, the above citations illustrate that the claimed shape provides the unexpected results, i.e. heat transfer between the grill pipes 21, the minimization of heat loss due to interception, and smooth circulation of water in the grill pipes 21, the Office Action alludes to on page 3."* However, absent persuasive evidence that the particular configuration of the claimed container is significant, applicant's position that the claimed shape provides the unexpected results is not found to be persuasive. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in

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the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3-7, 9: Rejected under 35 U.S.C. 103(a)

Claims 1, 3-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '440 (Japanese 2001-120440) in view of Potts (U.S. Patent No. 1294159).

JP '440 discloses the invention substantially as set forth in the claims with possible exception to each grill pipe having an oval cross section with relative height and width dimensions in the range set forth in applicant's claims.

JP '440 shows a roasting grill supported above a heat source/cabinet and including water tanks (601) interconnected by downward/upward bent or inclined laterally extending water pipes (602).

Potts teaches, from the same roasting/cooking grill field of endeavor as JP '440, forming food-supporting grill pipes to have an oval cross section.

In regard to claims 1-9, for the purpose of providing a suitable pipe cross section to, for example, limit the surface area each pipe contacts the food item supported thereon, it would have been obvious to a person having ordinary skill in the art to modify the cross section of the JP '440 pipes to be oval. In regard to claims 2-4, 6, 8 and 9, since the relative height and width dimensions of the tubes would necessarily depend on numerous design parameters such as the length of the pipes, operating temperature, pipe material, etc. to dimension the relative height and width of the JP '440 pipes according to the values set forth in applicant's claims can be viewed as nothing more than merely a matter of choice in design absent the showing of any new or unexpected results there from over the prior art of record.

Claims 10, 11: Rejected under 35 U.S.C. 103(a)

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '440 (Japanese 2001-120440) in view of Potts (U.S. Patent No. 1294159) as applied to claim 7 above, and further in view of Siegel et al (U.S. Patent No. D479435).

JP '440 discloses the invention substantially as set forth in the claims with possible exception to the roaster grill having a laterally extending central and upwardly extending bent, or inclined, end portions forming a cradle or rack for supporting food items.

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Siegel teaches, from the same the same roasting/cooking grill field of endeavor as JP '440, providing a roaster grill with laterally extending central (not referenced) and upwardly extending bent, or inclined, (not referenced) end portions forming a cradle or rack for supporting food items.

In regard to claims 10 and 11, for the purpose of providing a cradle for food items supported thereon, it would have been obvious to a person having ordinary skill in the art to modify the central portion of the JP '440 pipes to be flat, in view of the teaching of Siegel.

Conclusion

See the attached PTO FORM for prior art made of record that is not relied upon, which is considered pertinent to applicant's disclosure.

US004261328 shows flat tubes (22; figure 3).

JP03-265216 shows flat alternative flat (figure 4) and round tubes (figure 3).

FR 2 587 092 shows rectangular tubes (4).

JP2000-166771 shows a roaster with a water filled grate (4) and tanks (2).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

USPTO CUSTOMER CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARL D. PRICE whose telephone number is (571) 272-4880. The examiner can normally be reached on Monday through Friday between 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira Lazarus can be reached on (571) 272-4877. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Carl D. Price', with a long horizontal stroke extending to the right.

CARL D. PRICE
Primary Examiner
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cp